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EXAMINER

GEORGEWILL, OPIRIBO

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,458	Applicant(s) MOELLER, TORBEN LILTORP	
	Examiner OPIRIBO GEORGEWILL	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/20/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to Applicant's amendment filed on 11/20/09. Claim 20 is newly added.

Response to Arguments

2. Applicant's arguments filed 11/20/09 have been fully considered but they are not persuasive.
3. Applicant argues that on page 9, line 21 that Akahane (US Pat 6226533 B1) does not teach or suggest a user interface configured to display a first counter on a display counting the recorded length of the audio data being recorded. And Akahane teaches away from providing an indicator in form of a display.
4. Examiner respectfully disagrees, since, Akahane clearly teaches various types of counter displays (see col 5, lines 33 - 50) counting the recording length of the audio data (col 4, line 48 - col 5, line 9; fig 1, ref 60). The first counter counting is given its broadest reasonable interpretation, which is not limited to numeral values, as required by the MPEP § 904.01. Furthermore, MPEP § 2145 X(D)(1) states that "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)", which therefore adds numeral indication within the scope of the rejection of Dolan in view of Akahane.

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5. Applicant argues on page 10, line 6 – 15, that one having ordinary skills in the art would not consider combining Watkins (US Pub 20050180392) which deals with text, with either Akahane or Dolan (EP 0981252 A2), which deal with audio.
6. Examiner respectfully disagrees, since, Dolan clearly discloses text-message oriented service to deliver short audio messages (paragraph [8]), which would make one having ordinary skills in the art to look at both text and audio solutions to reduce message size.
7. Applicant argues on page 10, line 22, Watkins does not count the length of the message as it is entered, but rather processes the complete message
8. Examiner respectfully point out that the Watkins reference was not introduced to show the counting of the length of the message.
9. Applicant argues on page 10, line 24, that Watkins does not count how many SMS messages will be required to transmit the complete message as the message is being entered but after the after the user has entered the message
10. Examiner respectfully points out that a person having ordinary skills in the art would not limit the claim limitation "a second counter counting the number of recorded audio data packages" to being performed while the message is entered as argued by the Applicant. The Examiner is required by MPEP § 904.01 to give a claim the broadest reasonable interpretation and Dolan in view of Akahane and further in view of Watkins clearly display a second counter counting number of record audio data packages. Furthermore, Watson does indeed teach counting as the message is being entered. The cited section by Applicant, paragraph [63],

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refers to fig. 1, refs 16, 18, 20, 26, which is independent of process of the display output fig 1, refs 16, 18, 20, 22, 24. Finally, Watkins clearly discloses that a determination has been made on the number of portions of the message there has to be before the sending (paragraph [63], and splits the message into ***the determined*** (emphasis added) number of...) and it can therefore not be concluded that the count is after the user has entered the message.

11. Applicant argues on page 9, line 13 – 18, that Dolan does not disclose claim 18.

12. Examiner respectfully disagrees, since, claim 18 it is a method claim drawn to the apparatus claim 1, and is rejected for the same reason as claim 1 because implementing the apparatus would necessitate carrying out the method claim as claimed. Furthermore Dolan in view of Akahane and further in view of Watkins discloses when the first counter is smaller than said predefined length (Dolan: paragraph [33]; Akahane: col 3, lines 32 – 35, maximum predetermined message duration is reached)

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining

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obviousness under 35 U.S.C. 103(a) are summarized as follows: **(See MPEP Ch. 2141)**

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

14. Claims 1 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan, Michael Francis., European Patent Pub. No. 0981252 A2 in view of Akahane, Masaaki., US Pat No. 6226533 B1 and further in view of Watkins, Andrew., US Pub. No. 20050180392 A1.

Re claim 1, Dolan discloses a terminal (fig 3, ref 120) for concatenating recorded audio data packages each having a predefined length (see paragraph [8], Short Audio Message), into an audio message of variable length (paragraph [27]), each of said recorded audio data packages forwarded from said terminal to a receiving terminal through an interconnecting telecommunication network (paragraph [24] , SMS message sent across one or more intervening networks between a message center and the end user's equipment), and said terminal comprising:

(b) a recorder for recording each of said audio data packages (fig 3, ref 304, paragraphs [21], [44]),

(c) a concatenation unit for concatenating said recorded audio data packages into said audio message (fig 3, ref 315, paragraph [45]), and

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(d) a transmitter for transmitting each of said recorded concatenated audio data packages through said telecommunication network to said receiving terminal (fig 1, paragraphs [29] - [30]).

Dolan discloses the claimed invention but is silent on the user interface. Akahane in analogous art discloses a system for where voice messages are transmitted and received that includes a message indicator so as to stimulate message brevity in a user (see Akahane, abstract; paragraph 1, lines 6 – 11; paragraph 3, lines 32 – 36). Akahane further discloses user interface to display a duration indicator or remaining message memory capacity indicator (counter for counting the length of an audio message) (col 4, line 48 - col 5, line 9; fig 1, ref 60). The counting of recorded length and the remaining length are with the same skill sets of a person having ordinary skills and the choice of which to display is design choice. It would therefore have been obvious to a person having ordinary skills, at the time of the invention, to incorporate the teaching of Akahane into the disclosure of Dolan to display a counter counting recorded length of audio data being recorded in an audio data package so as to stimulate message brevity to a user.

Dolan in view of Akahane discloses the claimed invention but is silent a second counter counting the number of audio data packages. Watkins in analogous art discloses a system that preparing and storing message to be transmitted over a network (see abstract) so as to reduce message size (paragraph [6]). Watkins further discloses that a device may indicate on the display out device how many

portions are presently contained in the message (paragraph [60]). It would therefore have been obvious to a person having ordinary skills, at the time of the invention, to incorporate the teaching of Watkins into the disclosure of Dolan in view of Akahane, as a whole, to have a second counter counting the number of recorded audio data packages so as to reduce message size.

The rejection of claim 1 is incorporated herein. Claims 2, 3, 4, 5, 6, 7 and 20 depend on claim 1 and only further limitations will be addressed below.

Re claim **2**, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses that recorder comprises a microphone (Dolan: paragraph [17], the mobile user may also utilize this invention to be the initiator of a short audio message; also paragraph [1] discloses the mobile to be a mobile telephone; it would be obvious to a person having ordinary skills in the art that a telephone would have a microphone)

Re claim **3**, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses a predefined length (Dolan: paragraph [33], discloses a message limit of 10 seconds).

Re claim **4**, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses the terminal is a mobile telephone (Dolan: paragraph [1]).

Re claim **5**, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses that the receiving terminal is a mobile telephone (Dolan: paragraph [1]).

Re claim **6**, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses wherein said receiving terminal comprises a computer terminal (Dolan: paragraph [13], personal computer), in a computer network (Dolan: paragraph [13], intervening network could be the internet), said computer terminal being adapted to connect to said telecommunication network through a gateway interconnecting said telecommunication network and said computer network (paragraph [27], intervening networks between message center and end user's equipment. A person having ordinary skills in the art, at the time of the invention would recognize this when the terminal is a wireless phone connected via one of the wireless radio links (see paragraph [30]) and the receiving device is a computer connected to the internet)

Re claim **7**, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses that the telecommunication network is wireless (paragraph [30]).

The rejection of claim 7 is incorporated herein. Claim 8 and 9 depend on claim 7 and only further limitations will be addressed below.

Re claim **8**, the combined teaching of Dolan in view of Akahane and further in view of Watkins is silent on the telecommunication network using general packet radio service transmission format. However the combined prior arts disclose using GSM standard (paragraph [32]) which at the time of the invention GSM users could use GPRS. It would therefore be obvious to a person

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having ordinary skill in the art, at the time of the invention, to use GPRS transmission format because it would have been obvious to try.

Re claim **9**, the combined teaching of Dolan in view of Akahane and further in view of Watkins is silent on the telecommunication network using universal telecommunication services transmission service. However the combined prior arts disclose a GSM standard (paragraphs [31] - [32]) which at the time of the invention UMTS used GSM's Mobile Application Part and the GSM family of speech codecs). It would therefore be obvious to a person having ordinary skill in the art, at the time of the invention, to use UMTS transmission format because it would have been obvious to try.

Re claim **10**, the first limitation is rejected for the same reasons as claim one. Furthermore, the receiving and outputting of the audio and telecommunication network for interconnecting the transmitter and receiver are expected in the terminal disclosed in the rejection of claim one (see Dolan paragraph [17], where Dolan discloses that the same mobile unit can be initiator or receiving unit.; paragraph [19], the audio message is subsequently played back (loud speaker) to the recipient).

The rejection of claim 10 is incorporated herein. Claims 11, 12, 13, 15 depend on claim 10 and only further limitations will be addressed below.

Re claim **11**, it contains similar limitations to claim 2 and is rejected for the same reasons as above.

Re claim **12**, it contains similar limitations to claim 5 and is rejected for the same reasons as above.

Re claim **13**, it contains similar limitations to claim 6 and is rejected for the same reasons as above

Re claim **15**, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses wherein the transmitting terminal and the receiving terminal are interconnected via a wireless telecommunication network (fig 1, paragraphs [29] - [30])

The rejection of claim 13 is incorporated herein, claim 14 depends on claim 13 and only further limitations will be addressed below.

Re claim **14**, it contains similar limitations to claim 6 and is rejected for the same reasons as above.

The rejection of claim 15 is incorporated herein. Claims 16 and 17 depend on claim 15 and only further limitations will be addressed below.

Re claim **16**, it contains similar limitations to claim 8 and is rejected for the same reasons as above

Re claim **17**, it contains similar limitations to claim 9 and is rejected for the same reasons as above.

Re claim **18**, it contains similar limitations to claim 1 and is rejected for the same reasons as above

Re claim **19**, it contains similar limitations to claim 1 and is rejected for the same reasons as above.

Re claim **20**, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses wherein the recorded audio data package are short audio messaging (SAM) messages (paragraph [8])

Conclusion

15. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to OPIRIBO GEORGEWILL whose telephone number is (571)270-7926. The examiner can normally be reached on Monday through Thursday, 9:00am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LunYi Lao can be reached on (571)272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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